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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,708	07/16/2004	Konrad Roeingh	HM-594PCT	5110

7590 03/22/2006  
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EXAMINER

PATEL, VISHAL A

ART UNIT PAPER NUMBER

3673

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/501,708	ROEINGH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vishal Patel	3673	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 5 and 10, “at least one outwardly extending lip” and “at least one of said outwardly extending lips”, unclear to how many lips applicant is trying to claim? Furthermore as showed in the reference of Slater that there is an annular body made of two members, one of the members having a first and second lips and the other of the member having first and second lips.

Claim 8, lines 7 and 12, “at least one outwardly extending lip” and “at least one of said outwardly extending lips”, unclear to how many lips applicant is trying to claim? Furthermore as showed in the reference of Slater that there is an annular body made of two members, one of the members having a first and second lips and the other of the member having first and second lips.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Slater, Jr. (US. 4,099,731).

Slater discloses rolling device with at least one roll (14) rotatably supported in a stand and with at least one sealing device that seals the roll against a stationary area (stationary area having surfaces 50 and 52) of the rolling device. The seal device comprising at least one annular body (seal 38) supported on a roll neck (neck 16) and encompasses the roll neck (the seal encompasses the roll neck 16). The annular body being provided with at least one outwardly extending lip (lips 104b and 106b) that rests against and seals a stationary part (part having surfaces 50 and 52) during rotation of the roll. The annular body comprises at least two parts (38a and 38b). The first part rests against a part of the roll (part of 38a that rests against the roll 14 having the roll neck 16) and the second part comprises the at least one outwardly extending lip and the second part is held in a pocket of the first part (the second part is held in a pocket of the first part). The second part encompasses at least one lip directed axially in the direction of the barrel of the roll and one lip directed axially in the opposite direction (the lips 104b and 106b are in opposite direction).

The first part and the second part have different moduli of elasticity (since the material of the two parts are different it would have different moduli, column 5, lines 50-54). The first part

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and the second part have different surface hardness values (this is also true because they are formed of two different material). The first and the second part consist of different material (column 5, lines 50-54). The lip or lips consist of an elastic rubber material.

The limitations the second part is in a recess of the first part (as seen in figure 1, the second part 38b is in a recess of the first part 38a).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater in view of Slater Jr. (US. 4,022,480, now referred to as Slater '480).

Slater discloses the invention substantially as claimed above but fails to disclose that the lip or lips are spring supported. Slater '480 discloses a roll neck having a sealing device that has lips (lips of figure 1 which do not have spring support) and lips (lips showed in figure 4 that have spring supports 110). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the lips of Slater to have spring supports as taught by Slater '480, to provide additional means for urging (column 5, line 64-column 6, line 5 of Slater '480).

***Response to Arguments***

8. Applicant's arguments filed 12/19/05 have been fully considered but they are not persuasive.

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Applicants' argument that the added limitation pocket to the claim overcomes the reference of Slater is not persuasive because Slater teaches a first part to have a cavity that receives a second part into the first part.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., means which are not required in the configuration according to the present invention as claimed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' argument that due to the pocket that receives the second part no additional retaining means (adhesive or screws) are necessary is not persuasive because this is not claimed by the applicant. Furthermore evidence is shown by Pringle to have a lip seal that is retained on an L-shape clip or a U-shape clip as in figures 3 and 5, respectively. Furthermore due to the structure of a U-shape clip having the pocket there is no necessity for fastener means and applicant has failed to claim the particular structure of the pocket that make it possible to have no fastening means and has not claim the fact that fastening means are not used in this invention.

Even if the applicant claim the particular structure of the pocket the claim would not be allowable in view of the reference of Pringle.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP  
March 18, 2006

A handwritten signature in black ink, appearing to read 'Vishal Patel', with a stylized flourish at the end.

Vishal Patel  
Patent Examiner  
Tech. Center 3600